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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/974,584	11/19/1997	THOMAS R. CECH	015389-00295	8401

34151 7590 03/28/2007
TOWNSEND AND TOWNSEND AND CREW LLP
8TH FLOOR
TWO EMBARCADERO CENTER
SAN FRANCISCO, CA 94111

EXAMINER

MYERS, CARLA J

ART UNIT	PAPER NUMBER
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1634

MAIL DATE	DELIVERY MODE
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03/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	08/974,584	CECH ET AL.	
	Examiner	Art Unit	
	Carla Myers	1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 13 March 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 119, 129 and 130.
Claim(s) withdrawn from consideration: 127 and 131.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

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ATTACHMENT TO ADVISORY:

1. Continuation of Box 5:

a) Applicants reply has overcome the obviousness-type double patenting rejections of claims 119, 129 and 130 over U.S. Patent Application 10/044,539 and U.S. Patents 6,261,836, 6,927,285, 6,921,664, 6,337,200, and 6,475,789.

The terminal disclaimer filed on March 13, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Application 10/044,539 and U.S. Patents 6,261,836, 6,927,285, 6,921,664, 6,337,200, and 6,475,789 has been reviewed and is accepted. The terminal disclaimer has been recorded.

b) Applicants arguments regarding the obviousness-type double patenting rejection of claims 119, 129 and 130 over U.S. Patent No. 6,444,650 are convincing and the rejection is hereby withdrawn. It is noted that the claims of the '650 patent encompass an isolated antisense oligonucleotide that hybridizes to a target DNA having the nucleotide sequence of SEQ. ID NO:1 at 5 C. to 25 C. below T_m in aqueous solution at 1 M NaCl. The '650 patent (col. 4) defines oligonucleotides as being limited to a length of approximately 7 nucleotides and up to as many as "approximately 100 nucleotides in length." Thereby, the claims of '650 are not considered to encompass or render obvious the presently claimed nucleic acids which encode for a protein that comprises an amino acid sequence that has at least 60% identity to SEQ ID NO :118 when the entire sequence of the protein is optimally aligned with SEQ ID NO: 118 and

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wherein said protein has telomerase catalytic activity when complexed with a telomerase component.

2. Continuation of Box 11:

a) The request for reconsideration has been considered but does not place the application in condition for allowance because the obviousness type double patenting rejections of claims 119, 129 and 130 over U.S. Patent Applications 10/877,124, 09/721,477, 09/721,506 and 11/207, 078 are maintained.

In the response Applicants state that these applications are at varying stages of prosecution and it is not clear as to what claims will be prosecuted or allowed in these cases. Applicants request that the rejection be withdrawn.

This argument has been fully considered but is not persuasive. As set forth in the MPEP 804 I(b):

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications.

In the present situation, there are five applications containing conflicting claims and each application has the same filing date of April 18, 1997. Further, the present application is not considered to be a base application with respect to each of applications 10/877,124, 09/721,477, 09/721,506 and 11/207, 078. Therefore, the rejections are maintained because an appropriately filed terminal disclaimer is required to overcome the present grounds of rejection.

b) In the response filed March 13, 2007, Applicants request rejoinder of withdrawn claims 127 and 131 upon the allowance of the product claims 119, 129 and 130. However, claims 119, 129 and 130 have not been found to be allowable for the reasons set forth above. Accordingly, claims 127 and 131 remain withdrawn from consideration as being drawn to a non-elected invention. Further, it is noted that amendments, affidavits and evidence submitted after final are governed by 37 CFR 1.116 (see MPEP 821.04 and 821.04(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is 571-272-0747. The examiner can normally be reached on Monday-Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Carla Myers

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CARLA J. MYERS
PRIMARY EXAMINER